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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,566	01/11/2001	Allan Stuart Algazi	1071	9680
23720	7590	07/17/2006	EXAMINER	
WILLIAMS, MORGAN & AMERSON 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			WEBB, JAMISUE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/759,566

Applicant(s)

ALGAZI, ALLAN STUART

Examiner

Jamisia A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 4-9, 16-21 and 24-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 10-12 is/are allowed.
- 6) ☒ Claim(s) 13-15, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**


In view of the Appeal Brief filed on 4/21/06, PROSECUTION IS HEREBY REOPENED. New Grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
DENNIS RUHL  
PRIMARY EXAMINER  
*Acting SPE 3629*

***Claim Rejections - 35 USC § 101***

1. Claims 13-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 13-23 are drawn to an apparatus, which is limited to structural limitations only. Claim 13 recites "a notifier" and "a provider" and Claim 14 recites

“a presenter”, which these phrases appear to be a human who performs the activities such as providing, notifying and presenting. Claim 13 states the use of “a notifier” which notifies a user electronically that a package has arrived. The specification is silent as to what the “notifier” is. A human, can send an e-mail to a receiver that a package has arrived, therefore a human can be a notifier for notifying a user electronically that a package has arrived. Claim 13 also recites the limitation “a provider” which is also a human. According to the specification, the provider is the entity responsible for sending the package. The provider is the sender, not part of the apparatus that delivers goods to a user. Claim 14 discloses the use of “a presenter” for visual inspection. In order for there to be visual inspection, which leads to the presenter being a human, since there is visual inspection. A human or a human body part is considered to be non-statutory material, and is therefore not permitted to be positively claimed.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 13, 14, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Recktenwald et al. (6,439,345).

4. With respect to Claims 13: Recktenwald discloses the use of an apparatus comprising:

- a. A notifier (notifying paging system 116), for notifying a user electronically that the item is ready for pick-up (column 5, lines 19-31 and Claim 13);
- b. A scanner that scans a two-dimensional barcode (See Figure 5, reference numeral 200, with corresponding detailed description, the scanner of Recktenwald, scans barcodes which are two-dimensionally printed, therefore the examiner considers the barcodes to be a two-dimensional barcode. Furthermore, the type of barcode scanned is considered to be intended use of the apparatus itself);
- c. A decoder (Recktenwald discloses the scanner scans the barcode, then used the information to look up customer information, including purchase information. Therefore it is inherent that the system of Recktenwald comprises a decoder, due to the fact that the information within a barcode is not human readable, it is machine readable, therefore there must be a decoder present that will take the barcode, and decode it in order to find customer information from the database.)
- d. A collector for collecting user information (Recktenwald discloses the kiosk collecting user information such as name or telephone number. Page 6, column 55-64. The limitation of the user information being "biometric information" is deemed non-functional descriptive material, and not functionally related to the claimed apparatus, and is considered to be intended use of the apparatus itself. As noted above, the claims are drawn to an apparatus, which is limited to the structural limitations, not intended use. It is the examiner's position that Recktenwald is fully capable of collecting biometric information, such as facial features of the user).

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- e. A comparator (Paragraph 6, line 55 to Column 7, line 14, after reading the barcode, the system of Recktenwald, compares the entered information with the database, to look up customer information and to identify the customer, the examiner considers this to be a comparing step);
  - f. A provider for providing the package to the user (see abstract, the stock room person will pull the item and give it to the customer after the customer is identified)
5. With respect to Claim 14: Recktenwald discloses the use of a system presenting a description as well as a visual picture of the item to be picked up before it is provided to the customer (See Figure 12).
6. With respect to Claim 22: Recktenwald discloses the user information contains the customer name, it is the examiner's position that the name, is considered to be information related to the signature. Furthermore, Recktenwald, discloses the apparatus comprises a signature pad (Figure 23)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Recktenwald as applied to claim 13 above, and in view of Stephens et al. (6,323,782).

10. Recktenwald discloses the use of notifying electronically when an item is ready for pick-up using a paging system or using RF transmission, but fails to disclose electronically notifying the user via cell phone. Stephens discloses the use of a delivery system where a receiver or customer is notified via RF transmission or via cell phone, when an item is delivered to the location and ready for pick-up (column 9, lines 39-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the notification of an item being ready for pick-up as disclosed by Stephens, in the system of Recktenwald, in order to provide the customer information that is remotely passed without the use or dependency on lines or cables, and therefore allowing the information to be sent to remote locations. (See Stephens columns 9-11)

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Recktenwald as applied to claim 13 above, and in view of Keagy et al. (6,069,969).

12. Recktenwald, as disclosed above discloses the use of a barcode scanner, however does not specifically disclose the use of the barcode using RDF 417 technology. Keagy discloses the use of a barcode that is encrypted with biometric information for use in verification purposes,

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and utilizes PDF 417 barcodes (column 10, lines 57-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the barcode of Recktenwald be the 2D barcode using PDF symbols, as disclosed by Keagy, in order to provide a template that can encode a user's biometric information and to allow for a more secure encryption of the data. (See Keagy, column 10)

***Allowable Subject Matter***

13. Claims 1-3, and 10-12 are allowable over the prior art of record.

***Response to Arguments***

14. Applicant's arguments, see Appeal Brief, filed 4/21/06, with respect to Claims 1-12 have been fully considered and are persuasive. The prior art rejection of Claims 1-3 and 10-12 has been withdrawn.

15. Applicant's arguments with respect to claims 13-23 have been considered but are moot in view of the new ground(s) of rejection. In the Appeal Brief filed 4/21/06, the applicant has argued the apparatus claims, in terms of the rejection lacks a motivation to combine. Upon further consideration, the examiner has modified to apparatus rejection to be a 102 rejection, as stated above. The examiner has also added a 101 rejection onto the claim, therefore the arguments no longer pertain to the rejections of record.

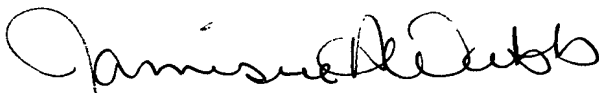


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jamisue Webb

  
DENNIS RUHL  
PRIMARY EXAMINER